

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of	:	OFFICE OF PETITIONS
Engelhardt et al.	:	Ms. Nancy Johnson
Application No. 08/486,069	:	Senior Petitions Attorney
Filed: June 7, 1995		
Atty Docket No. ENZ-5(D8)(C2)	:	Confirmation Number: 6728

**MAIL STOP PETITION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RENEWED REQUEST TO VACATE ORDER TO SHOW CAUSE WHY  
DECISION REVIVING THESE APPLICATIONS SHOULD NOT BE VACATED**

Dear Commissioner:

This is a Renewed Request to Vacate the Order to Show Cause Why Decisions Reviving Applications Should Not Be Vacated ("Order") issued in the above-captioned '069 application, which is a File Wrapper Continuation ("FWC") of parent application 07/954,772 ('772), in which an Order was also issued.

Petitioner respectfully urges that no fees are due because the Show Cause Order was improperly issued. Nevertheless, should the PTO determine that any fees are required to have the Order vacated, including any extension of time fees, the PTO is authorized to charge Deposit Account No. 50-2929, making reference to Docket Number J10008.

The '772 application became abandoned February 4, 1994, for failure to reply to the Office action mailed November 4, 1993, which set a shortened period for reply of three months. A Notice of Abandonment was mailed June 4, 1994. A petition to revive under 37 CFR 1.137(b) was filed February 3, 1995, and was granted by the decision of March 20, 1995.

The instant FWC application became abandoned on March 29, 1996, for failure to reply to the Office action mailed December 28, 1995, which set a shortened statutory period for reply of three months. A Notice of Abandonment was mailed July 22, 1997. A petition to revive under 37 CFR 1.137(b) was filed March 28, 1997, and was granted by the decision of July 9, 1997.

On July 1, 2008, some 13 years after the petition in the '772 application was granted, and some 11 years after the petition in the instant '069 application was granted, the USPTO in an apparently "exceptional" action issued an Order to Show Cause ("OSC") in this and other Enzo applications that had become abandoned. The OSC required a showing as to why the favorable decisions on petition going as far back as some 15 years should not now be vacated. The OSC supposedly justified itself by referring to a purported "pattern" of abandonment and revival of the Enzo applications listed therein, and also cited an innocuous statement made by Enzo's attorney involving

his preparation of a reply in another application unrelated to this application, and at a time unrelated to this application.<sup>1</sup>

On December 6, 2008, Enzo filed a Petition to Vacate the OSC in both the ‘772 and ‘069 applications as well as all other applications listed in the OSC, a Petition to Expunge Confidential Information, as the OSC violated the USPTO’s own obligation to maintain the confidentiality of several Enzo applications (including both the ‘772 and instant ‘096 applications) disclosed in the OSC by way of their inclusion when the OSC was made of record in the other publicly available applications, and a petition to expedite consideration of the other petitions.

However, on June 4, 2009, the USPTO issued another OSC. While substantially identical to the first, this OSC only permitted a non-extendible two month period for reply.

Petitioner Enzo requests reconsideration and vacatur of the Order to Show Cause improperly issued July 2, 2008, and June 4, 2009, (collectively the “OSC”).

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<sup>1</sup> There, the USPTO refused to accept the statement of unintentional delay as made, subsequently denied that it had refused the petition, and then refused to further consider a renewed, supplemented petition. This egregious course of USPTO conduct towards Enzo in that case was rightfully overturned by the court and remanded to the USPTO for consideration of the supplemented petition. See *Enzo Therapeutics, Inc. v. Yeda*, 477 F.Supp.2d 699 (E.D.Va., 2007). It is significant that the USPTO granted that renewed petition under 37 CFR 1.137(b) (after, however, the OSC was herein issued), which belies the totally fabricated argument advanced herein in support of the OSC that Mr. Fedus’ testimony in that other case raises a question in this case—or indeed any other Enzo case-- as to whether the abandonment and delay was unintentional. Enzo strenuously protests its subjection to, and demands its release from, this continued USPTO arbitrary and capricious behavior. Enzo presumes that this renewed petition and supplemental statement made by, *inter alia*, Mr. Fedus, will likewise result in favorable reconsideration herein.

In this renewed request, Enzo also responds, in an abundance of caution, to the allegations made in a Decision mailed April 3, 2009, (“Decision”) (issued in most Enzo applications listed in the OSC, but not in either the ‘772 or instant ‘069 applications) which dismissed Enzo’s previous request filed November 11, 2008, to vacate the Order. In addition, this renewed request includes an exhaustive Declaration by Mr. Ron Fedus, patent attorney and corporate counsel for Enzo, which details, *inter alia*; the manual docketing system employed by Enzo, and provides specific answers to the questions posed by the Order and Decision for this application. Although Enzo properly believes the Order as issued was untimely, and lacked any reasonable basis for suggesting reconsideration of its previous favorable decisions on revival, Enzo is, to the extent possible after the long passage of time, making a diligent and good faith effort to comply with the Order’s request for information bearing on the delay in this application.

#### The Order Was Improperly Issued

##### 1. The USPTO Lacks Jurisdiction over the ‘772 Application and Has Lost Its Jurisdiction to now reconsider the decision in the instant ‘069 application

Interestingly, the USPTO now contends in the Decision (at 9) that Enzo does not question the USPTO’s jurisdiction to issue the Order in the abandoned ‘772 application, as well as in the instant ‘069 application. Rather it is alleged, Enzo has only contended the Order is “unreasonable..” This is an incorrect interpretation of Enzo’s arguments presented in subsection B of the previously filed Request to Vacate the Order to Show Cause. The point of these arguments is precisely that: the USPTO when it had

jurisdiction of petition in the '772 application in 1995, and jurisdiction of the petition in the instant '059 application 1997 *in each instance* it then also had the ability to request additional information regarding the delay in each application, and yet it chose not to do so.

The U.S. Court of Claims has explained that, "absent contrary legislative intent or other affirmative evidence, this court will sustain the reconsidered decision of an agency, as long as the administrative action is conducted within a short and reasonable time period." *Belville Mining Company*, 999 F.2d at 1000 (citing *Bookman v. United States*, 453 F.2d at 1265) (emphasis added). The Court of Claims later clarified that "[w]hat is a short and reasonable time period will vary with each case, but absent unusual circumstances, the time period would be measured in weeks, not years." *Id.* at 1000 (citing *Gratehouse v. United States*, 512 F.2d 1104, 1109 (Ct. Cl. 1975)) (emphasis added). The court added that since this reasonable time period has run, 'there is no longer an opportunity to correct the procedural error retroactively.' *Id.* at 997 (citing *Gratehouse*, 512 F.2d at 1109). Certainly after the passage of some 13 years from the decision in the '772 application, and 11 years from the decision in this application, the USPTO has lost any opportunity it had to question the delay in either case—particularly since it has not shown that any procedural error was committed by either the USPTO or Enzo in either application.

The doctrine of reliance militates against the propriety of the Order and the belated resurrection of jurisdiction by the USPTO. The USPTO apparently overlooks that since the first petition was granted in 1995, Enzo has continuously relied upon (1) that revival for subsequent pendency in that application which is also necessary for

continuity with the instant FWC application and upon which the filing date of the instant FWC was contingent under former 37 CFR 1.62, (2) the filing receipt issued in this continuing application, in which the USPTO acknowledged the claim for benefit of the '772 application in the FWC continuing application, and (3) the long prosecution history of this FWC continuing application which was accorded benefit of the filing date of the '772 application. Moreover, Enzo, since the decision of 1995 in the '772 application, and the decision of 1997 in this application properly relied upon the USPTO acceptance of the assertions *as made*. That 13, and 11 year period, respectively of Enzo's reliance on that acceptance is now improperly and belatedly challenged by the USPTO's assertion in this file that there is a "question" as to whether those revivals were properly made and accepted. The fact is that the USPTO long ago gave up any jurisdiction that it may have had over this application. Also the doctrine of reliance militates against the propriety of the Order and the belated resurrection of jurisdiction by the USPTO.

Enzo agrees that the courts have held that an administrative agency such as the USPTO, does have the inherent right to reconsider its own administrative decisions, but these same courts also held that this is *not an unlimited right of infinite duration*. Specifically, the USPTO reconsideration must be *timely*. *Dayle v United States*, 169 Ct. Cl. 305, 308 (1965). This is especially so where, as here, valuable rights (such as Enzo's right to the claim of priority from the '772 parent application under 35 U.S.C. § 120) have vested. *Id.* at 308. Further, during the long prosecution history of the instant '069 application, the USPTO has accorded Enzo the benefit of that priority claim: (1) the filing date of the prior '772 application vis-à-vis the prior art, and (2) the filing date of the instant application which was granted by the USPTO and contingent on copendency with

the ‘772 application (i.e., the prior application was properly revived and as such was certified by the filing receipt issued by the USPTO for this application) when the USPTO granted this application a filing date under former 37 CFR 1.62, and now seeks to renege on its own actions. The USPTO long ago lost its jurisdiction over this application.

In general, an agency right of reconsideration only extends somewhere between several weeks and several years after its initial decision. See *Belville Mining Company v. United States*, 999 F.2d 989, n.12 (6<sup>th</sup> Cir. 1993)(upholding as timely an 8 month period as intermediate between the matter of weeks upheld by most courts and the years of delay that are not). More importantly, that right should not be based upon a suspicion of possible intentional delay, but must be based on a solid evidentiary foundation, a circumstance not present here. Due to no fault of its own, Enzo’s records of—and memories of-- matters laid to rest so long ago are spotty at best. This is why the courts require reasonable promptness and a sound basis for agency reconsideration of its actions—it is a matter of equity and procedural due process for the involved party.

The USPTO has indicated that it generally expects some effort within 3 months after receipt of the Notice of Abandonment, or one year after the date of abandonment as a “criteria” for considering and accepting, without more, the statement of unintentional delay as written, but that is not relevant for either the ‘772 application or the instant application due to the version of 37 CFR 1.137(b) in effect when the petition in the ‘772 application and the petition in the instant ‘069 application were filed. The rule in effect for both petitions required that the petition be filed within one year of the date of abandonment and be accompanied by a statement that the delay was unintentional.

Indeed, the instant FWC application evidences that the delay in the prior '772 application was unintentional. See *Goss International v. MAN Roland, Inc.*, No. 03-CV-513-SM, 2006 U.S. Dist. LEXIS 53245 at \*13 (D.N.H. July 31, 2006) (court distinguishing between abandonment of an application that may be properly remedied by way of 37 CFR 1.137(b) where *e.g.*, evidenced by the filing of a continuation application to further prosecution of the disclosed invention, and the irremediable abandonment of the invention itself). Here a FWC continuation application was filed to continue the prosecution of the invention. Indeed, as the Order itself stipulates (at 10), it seeks information regarding Enzo applications, such as the instant '069 application, which are relied upon for priority of invention claims in subsequently filed and prosecuted Enzo applications to those self-same inventions. In other words, the Order targets those very Enzo applications that the Order itself indicates were properly revived. See *Goss, supra*.

In February 1995 and also in March 1997, a grantable petition required: (i) a statement that "the delay was unintentional"; (ii) a proposed response; and (iii) the petition fee. See 37 C.F.R. § 1.137(b) (1993); see *also* Manual of Patent Examining Procedure (MPEP) § 711.03(c), ("[a] decision on a petition to revive ... under 37 CFR 1.137(b) is based substantially on whether the statement that the delay was unintentional is present along with the required fee and the proposed response."). See respectively, 6th Ed. Jan. 1995; 6<sup>th</sup> Ed., Rev. 2, July 1996).

The USPTO has published two decisions wherein it reconsidered its previous acceptance of statements of unintentional delay, but there it did so (1) *promptly*, and (2) then only when it had a "smoking gun" document already in hand evidencing that the



delay was intentional. See *In re Patent No. 5,665,388* (May 12, 2005)<sup>2</sup>; *In re Patent No. 5,723,453* (May 12, 2005)<sup>3</sup> (Order to Show Cause issued January 27, 2004, seven months after decision granting petition under unintentional standard of 37 CFR 1.378(c), based on uncontroverted evidence in documents submitted September 23, 2003). Just as clearly as those reconsiderations were timely, the reconsideration of the decisions in both the '772 and the instant '069 application is not. See *Belleville, supra*. It should be noted that the documentary evidence of record in the published decisions *irrefutably* showed that the bankruptcy trustee made a business decision not to maintain in force, or reinstate, any of the patentee's patents, advised the lien holder bank not to spend any further funds on the patents, and further, instructed the registered practitioner of record to take no action to maintain or reinstate the involved patents, or to incur any expenses in the matter.

The USPTO has no evidence that a business decision not to continue prosecution was made in this application, or that there was a change in circumstance of the abandonment in this application which led to the revival petition. There is a valid reason why no such "smoking gun" evidence exists for either the '772 or the instant '069 application: neither application was intentionally abandoned and there was no intentional delay in seeking revival. Moreover, in both the '772 and instant '069 applications, as well as in every other Enzo application mentioned in the Order, the USPTO has not acted promptly in issuing the Order. In each application the USPTO is simply fishing

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<sup>2</sup> <http://www.uspto.gov/web/offices/com/sol/foia/comm/maint/5665388.pdf>

<sup>3</sup> <http://www.uspto.gov/web/offices/com/sol/foia/comm/maint/5723453.pdf>

for evidence to, retroactively, support its belated action. The USPTO makes no effort to explain, much less excuse, its long delay in questioning Enzo, and is conspicuously silent as to what triggered at this late date, the Order in both applications. In both the '772 and the instant '069 applications, as in every application mentioned in the Order, Enzo had not made any business decisions not to prosecute, or delay in seeking revival of, any of the applications in the Order, nor does the USPTO point to any evidence of such. Most importantly, there is no "smoking gun" evidence of any decision by Enzo not to prosecute, much less intentionally delay seeking revival, of any already abandoned application in the Order, especially the instant application. Thus, the USPTO's actions in the Order are not consistent with USPTO precedent when it capriciously reconsidered the previously granted petition under the unintentional delay standard in each and every Enzo application mentioned in the Order. Indeed, the only justification beyond the alleged "pattern" of abandonment and revival is the deposition testimony (irrelevant to this application but harmless in any event) of Mr. Fedus made in another Enzo application undergoing an interference, when the lack of co-pendency with a prior Enzo application was discovered during the interference and Enzo sought to remedy its inadvertent error with a petition under 37 CFR 1.137(b). As outlined above, there, the USPTO refused to accept the statement of unintentional delay as made, subsequently denied that it had refused the petition, and then refused to further consider a renewed petition. This course of action was overturned by a Federal District Court which remanded the case to the USPTO for consideration of the supplemented petition. See *Enzo Therapeutics, Inc. v. Yeda* 477 F.Supp.2d 699 (E.D.Va., 2007). Again, it should be noted that the USPTO has since granted that petition and Enzo presumes that this

renewed petition and supplemental statement made by, *inter alia*, Mr. Fedus, will likewise result in favorable reconsideration.

2. The USPTO fails to provide a reasonable basis to belatedly question the delay

The USPTO maintains (Decision at 11) that the Order is supported. Specifically, the USPTO contends there is a “pattern of abandonment and revival” alleged to be apparent from various Enzo applications, so as to justify the Order. Indeed, the USPTO contends without giving any support for its contention, that the abandonment of an application is not a routine matter. In fact, the opposite is true.

Abandonments are Routine at the USPTO

Inspection of the relevant Workload Tables of the USPTO Annual Reports listed on its web site (1993-2008)<sup>4</sup> reveals that in 1994, the year of abandonment of the ‘772 application number, about *seventy thousand (70,000)* other applications also became abandoned on an annual basis. Clearly, and contrary to the assertion in the Decision, abandonment of an application was (and remains) a rather routine matter at the USPTO.<sup>5</sup> In 1995, the year the USPTO granted the petition, it processed about

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<sup>4</sup> See <http://www.uspto.gov/web/offices/com/annual>

<sup>5</sup> For 2008, the year the Order was issued, the USPTO indicated that about *two hundred nine thousand (209,000)* applications became abandoned and that it processed

4,100 petitions to revive (the number of those petitions filed under the unintentional standard and their rate of success is not reported). That the vast majority of those abandoned cases were not subjected to attempted revival and permitted to remain abandoned suggests that the abandonment in those cases was not unintentional, or in any event, the delay in seeking revival was not inadvertent, especially given the 1 year filing requirement for a petition under 37 CFR 1.137(b).

Moreover, the fact that only a few attempts to revive were filed, as compared to the huge number of applications abandoned but were obviously *not* subjected to revival attempts that year, serves as objective support of Enzo's assertion in the 1995 petition that the delay in prosecution in this application and in filing the petition was unintentional.

In 1996, the year of the abandonment of this application number, about *sixty two thousand (62,000)* other applications also became abandoned.. Clearly, and contrary to the assertion in the Decision, abandonment of an application was (and remains) also a routine matter at the USPTO in 1996. In the same year the petition was granted (1997), the USPTO processed about 4100 petitions to revive (the number of those petitions filed under the unintentional standard and their rate of success is not reported). That the vast majority of those abandoned cases were not subjected to attempted revival and permitted to remain abandoned suggests that the abandonment in those cases was not inadvertent, or in any event, the delay in seeking revival was not inadvertent, especially given the 1 year filing requirement for a petition under 37 CFR

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about 10,000 petitions to revive. From 1993 through 2007, the years spanned by the Order, over *1.3 million* applications were reported abandoned.

1.137(b). Moreover, the fact that only a few attempts to revive were filed, as compared to the huge number of applications abandoned but were obviously *not* subjected to revival attempts that year, serves as objective support of Enzo's assertions in the 1995 and 1997 petitions that the delay in prosecution in each application and in filing the petition was unintentional.

#### Revivals Are Also Routine at the USPTO

Of course, there would be no "pattern" (discernable or not) of abandonment and revival if the USPTO had not granted the petitions herein and revived this application number and the others listed in the Order. But, after all, it is the USPTO, not Enzo, who rightfully granted the petitions to revive this application. Indeed, the Decision admits (at 10) that "[i]t is true that the Office generally grants petitions under 37 CFR 1.137(b)." The MPEP in effect in both February 1995 and March 1997 makes it clear that a petition to revive under 37 CFR 1.137(b) would generally be granted:

Generally, nothing else is required [for a grantable petition] unless *there is reason to believe that the delay was intentional* such as a letter of intentional abandonment being of record in the abandoned application. In such instance, the Office might inquire as to the circumstances surrounding the abandonment in order to clarify that the abandonment was, in fact, unintentional(emphasis added).

*see* Manual of Patent Examining Procedure (MPEP) § 711.03(c),(respectively, 6th Ed. Jan. 1995; 6<sup>th</sup> Ed., Rev. 2, July 1996).

Furthermore, there was no letter of express abandonment of record in either the '772 file or this file or any other indicia that would, then or now, trigger any further inquiry into the delay in this application. Indeed, the administrative record of this

application amply supports the correctness of the revival of both applications. Furthermore, the administrative records of the other Enzo application listed in the Order support the revivals in those cases. As argued previously, the fact that other Enzo applications may have later become abandoned (and revived) has no bearing on the question of delay in this application. The USPTO rejects this argument as meritless, and contends that as other Enzo application have become abandoned “on a regular basis” and revived, some of them with petitions filed close to one year from abandonment, this is somehow “significant”.

For the entire period involved in the Order, the USPTO had a full record of the cases and their status. Taking years-old, even decades-old information regarding other applications and putting it into a table does not somehow magically convert it to new information that is relevant to this application.

The mantra of the alleged “pattern of abandonment and revival” by which the USPTO seeks to impart disproportionate weight to questioning the delay in other cases to the petition herein, is an issue already decided in Enzo’s favor in this case, particularly since this application number became abandoned twice. How the USPTO could have failed to notice that fact at the time the second petition was filed, and then again when the third petition was filed is not explained in the Order, or how Enzo could have somehow withheld that fact from the USPTO, is likewise not explained in the OSC. Indeed, the Federal Circuit has rejected a similar approach, not of direct evidence, but of mere assertion and innuendo, to try, by repetition, to make a case that would unfairly force a detailed rebuttal by Enzo. See *Magnivision, Inc., vs. Bonneau*

*Co.*, 115 F.3d 956, 960, 42 USPQ2d 1925, 1929 (Fed. Cir. 1997) in which the court also noted:

The assertions and innuendos of impropriety were [improperly] magnified by repetition. See *Louisiana Ass'n of Independent Producers and Royalty Owners v. Federal Energy Regulatory Comm'n*, 958 F.2d 1101, 1119 (D.C. Cir. 1992) (a party "cannot, by sheer multiplication of innuendo, overcome the strong presumption of agency regularity") (quoting *United States v. Morgan*, 313 U.S. 409, 421 (1941)).

The presumption of USPTO regularity in the revivals of the '772 application and this application simply cannot be overcome by the mere allegation of a "pattern" of abandonment and revival in other Enzo applications. The '772 application and this application did become abandoned, but despite the regulation authorizing further inquiry by the deciding official *at each time*, no additional information was requested. Just how many other petitions in other, non-Enzo applications were filed in either 1995 or 1997 at around the one year period is not provided by the USPTO (i.e. is Enzo somehow unique in this matter) which points to its arbitrary and capricious inclusion of this application in the Order. To help place things in proper perspective, during the years from 1992 to 2007 which span the Order listing of the involved Enzo applications, over *1.3 million application became abandoned at the USPTO* .

The contention that there is a "pattern" of abandonment *and* revival in other Enzo applications listed in the OSC is simply due to the fact that the USPTO routinely revives abandoned applications under the unintentional standard of 37 CFR 1.137(b). The dismissal itself admits as much at 10 ("[I]t is true that the Office generally grants petitions under 37 CFR 1.137(b)"). The fact that several Enzo applications out of

Enzo's entire portfolio became abandoned over the 15 year period year mentioned in the Order (Table bridging pp. 11-12) is shown by the attached Declaration of Mr. Ron Fedus to be attributable to *inter alia*, (1) the use of a manual docketing system that did not automatically calculate reply dates; (2) the non-receipt by Enzo of several of the Office actions and/or Notices of Abandonment as apparently happened in this application, coupled with its aforementioned docketing system; (3) these applications are all in the field of Biotechnology, wherein complex, extended, and vigorous prosecution is a fact of life and Mr. Fedus always sought to present to the USPTO a complete reply to all issues, often having to consult with internal inventors and other industry experts and prepare declarations in addition to formulating responses and amendments to the Office actions<sup>6</sup>; and (4) Mr. Fedus was, for almost the entire 15 year period noted in the Order, Enzo's only patent counsel (and corporate counsel) who had a very full plate: licensing negotiation, litigation; opposition; and the preparation and prosecution of the hi-tech Enzo application families noted previously.

The Decision asserts (at 11) that Enzo has wrongly suggested that the USPTO must provide evidence that the delay was intentional. The decision further makes the incorrect assertion (at 9) that Enzo allegedly does not question the Office's jurisdiction to issue the Order in this abandoned application.

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<sup>6</sup> Attention is drawn to the fact that the Manual of Patent Examining Procedure was uniquely amended on and after August 1993 (5<sup>th</sup> Ed. Rev 15) to include a chapter drawn to the practice and procedures relating to a specific area of scientific endeavor: Biotechnology.



Enzo points out that after 13, and 11 years of USPTO acceptance of Enzo's prior statements of unintentional delay in, respectively, the '772 and applicaiton and the instant application,, that equity alone would suggest the USPTO needs something more than a dubious basis to reopen the matter of the delay in this application, which was long ago decided in Enzo's favor. This is particularly so since the USPTO has already repudiated its own allegation of Enzo wrongdoing by reviving the very application for which Mr. Fedus' remarks were cited in the OSC as a basis for further questioning Enzo delay in the Order. In other words, th3 '772 application—and this, its continuing application, have long and properly enjoyed the presumption of administrative correctness of the revival—and both the USPTO and Enzo have long and properly relied upon the favorable decision on petition. Enzo agrees that the USPTO, like any other administrative agency, does have the inherent right to reconsider an administrative decision, but strenuously insists th at this is not an unbridled right of infinite duration as the USPTO apparently believes. The USPTO long ago lost its jurisdiction over questions of delay in this application.

The Order admittedly focuses on those Enzo applications revived for continuity with a continuing application. This suggests that the USPTO seems to disapprove of—or find suspicious--Enzo filing a continuation application to continue prosecution of a given invention, as opposed to a substantive reply in the earlier application. Note that is precisely what happened in this instance; Enzo did file a substantive reply in both the '772 and this applicaiton and yet is still being targeted in both applications—perhaps because Enzo has filed a continuing application.

The USPTO fails to appreciate the distinction between the inadvertent abandonment of an application, which is properly revived under e.g., 37 CFR 1.137(b),

and the irremediable abandonment of the underlying invention, which is not. Irrefutable evidence that the underlying invention in both the '772 application and this application was not intentionally abandoned is the fact that a continuing application was filed to continue the prosecution of the same invention—which continues to this day in the instant '069 application. See *Goss, supra*. By focusing on those Enzo applications having continuing applications, the USPTO also overlooks that even given its long acceptance of continuing applications as proper reply. This is a matter of policy as noted in the MPEP of 1992, and was expressly added to USPTO regulation (37 CFR 1.137(b) (1)) in 1993 (and remains continuously to this day) which expressly authorizes that a petition may be accompanied by either a substantive reply or *the filing of a continuing application*. Accordingly these actions are equivalent responses by the USPTO's own formally stated policy and the mere fact that either a continuing application was filed, or as here, in both instances, a substantive response is, does not *ipso facto*, give evidence of intentional delay in prosecution or revival. See also *Goss, supra*.

Indeed, as Mr. Fedus makes clear in his Declaration he always sought to provide a substantive reply to accompany a petition to revive. It was only when he could not timely prepare that substantive reply to advance prosecution that he would file a continuing application as the proposed response to continue prosecution—which was as noted above was and is entirely proper under the rules of the USPTO. Now, however, the USPTO Decision flies in the face of its own rules and suggests the filing of a continuation application as the reply to accompany a petition to revive as somehow indicative that there may have been intentional delay on the part of Enzo. This baseless contention does not survive a mere inspection of the UPSTO's own rules.

The administrative record shows that the revivals were in accord with USPTO procedure and policy.

The USPTO has reconsidered its previous acceptance of statements of unintentional delay, but did so (1) promptly, and (2) when it had a “smoking gun” document already in hand evidencing that the delay in that case was intentional. See *In re Patent No. 5,665,388* (May 12, 2005) <http://www.uspto.gov/web/offices/com/sol/foia/comm/maint/5665388.pdf>; *In re Patent No. 5,723,453* (May 12, 2005) <http://www.uspto.gov/web/offices/com/sol/foia/comm/maint/5723453.pdf> (Order to Show Cause issued January 27, 2004, seven months after decision granting petition under unintentional standard of 37 CFR 1.378(c), based on evidence in documents submitted September 23, 2003).<sup>7</sup>

#### The Request for Information

Notwithstanding the USPTO’s lack of jurisdiction to now reconsider the grants of the petition of over 6 years ago, Enzo is making a good faith effort to reply to the Order. It must be stressed however, that again, the USPTO is overstating its case here as to what actually can be demanded pursuant to 37 CFR 1.137(b), and as such Enzo is concerned

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<sup>7</sup> It should be noted that the documentary evidence of record irrefutably showed that the bankruptcy trustee made a business decision not to maintain in force, or reinstate, any of the patentee’s patents, advised the lien holding bank not to spend any further funds on the patents, and further, instructed the registered practitioner of record to take no action to maintain or reinstate the involved patents, or even to incur any expenses in the matter.

that the additional statements and available evidence adduced with this petition will be improperly faulted by the USPTO.

Specifically, the Order requires (at 10), in addition to the “statements” actually permitted under the rule “*copies* of the relevant docket entries, including a *showing* of what action (or inaction) was docketed for a date three months from the mail date..., what action(or inaction) was docketed for a date six months, and what date was docketed for a date 1 year.... It is expected the *record would include...*”

The USPTO is reminded that the requirement for a “showing” is only found in 37 CFR 1.137(a), which is immaterial to the instant petition and Order. The requirement for a showing accompanied by docket evidence is simply not found in or authorized by 37 CFR 1.137(b). The Order and the Dismissal are overlooking the USPTO’s own interpretation of section 1.137(b). See the *Official Gazette* Notice entitled “Clarification of Application Revival Procedures (37 CFR 1.137)” published Aug. 31 1999 (emphasis added):

The PTO anticipated that the December 1997 revision to 37 CFR 1.137 would reduce the number of petitions under 37 CFR 1.137(a) (on the basis of “unavoidable delay”.) This is because petitions under 37 CFR 1.137(b) require less effort **(statement(s) rather than a showing accompanied by documentary evidence) and are evaluated under the less stringent “unintentional delay” standard.** ..Even if the PTO requires further information in a petition under 37 CFR 1.137(b), the petition under 37 CFR 1.137(b) is significantly less burdensome to prepare and prosecute than a petition under 37 CFR 1.137(a). The PTO is almost always satisfied that “the entire delay...was unintentional” on the basis of statement(s) by the applicant or representative explaining the cause of the delay **(accompanied at most by copies of correspondence relevant to the period of delay.)**(Emphasis added)

Nevertheless, Enzo affirms that it has made diligent efforts to comply with the Order since it was first issued and has tried to locate the requested documentary evidence such as docket records, correspondence relevant to the period of delay, etc. However, due to the extraordinary period of delay by the USPTO in reconsidering the petition herein, many of the records pertaining to the applications in issue have been lost or disposed of because of the passage of time (up to 16 years), the moving of offices, and the lack of storage space and a central server. In addition, at least three catastrophic computer malfunctions destroyed Enzo's records pertaining to patent prosecution matters.

Enzo herewith submits statements from: Mr. Barry Weiner ("Weiner"), Enzo Biochem ("Enzo") co-founder, President, and Chief Financial Officer, Mr. Ron Fedus ("Fedus"), Enzo Corporate Counsel and a patent attorney (from 1993 until about 2005 Enzo's only patent attorney), Ms. Lisa Curtin ("Curtin"), who was Enzo's docket clerk from June 1997 until April 2003; Ms. Amanda Liu, a paralegal, who handled the Enzo docket records from 2005 onwards; and docket records that could be found relating to the present application. These declarations and attached documents provide in narrative form as much of the information requested by the Order as can be found or recalled.

#### The Weiner Declaration

Mr. Weiner's Declaration attests that, despite the difficult financial situation at Enzo throughout most of the period covered by the Order which necessitated a drastic reduction in in-house legal and IP personnel, Enzo never deliberately abandoned an application nor delayed its prosecution. The USPTO should note this attestation confirms the statements made in the two granted petitions of record in this application. Indeed, as

Mr. Weiner declares, the revenues derived from its patent portfolio were crucial to Enzo's survival during this time of its "shoestring" operations.<sup>8</sup>

While the USPTO raises the allegation of intentional delay on the part of Enzo in either prosecution or revival, Mr. Weiner clarifies that Mr. Fedus' diligent and successful prosecution of its applications to generate an income stream for Enzo was essential to Enzo's continued livelihood; obtaining more patents was an Enzo priority. It would only hurt Enzo's precarious financial position to deliberately delay prosecution or revival of a given application.

Further relevant to the issue of abandonment of Enzo applications is Mr. Weiner's statement that when Ron Fedus was hired in 1990, he was one of four Enzo in-house IP and corporate attorneys, but by 1993, Mr. Fedus was Enzo's *sole* in-house attorney, and remained so until 2003; now Enzo has two full time IP attorneys. In other words, for most of the period set forth in the Order, Mr. Fedus had a workload that was formerly handled by 4 Enzo attorneys, but due to Enzo financial concerns, his support staff was not increased. As declared by Mr. Weiner (and affirmed in more detail by Mr. Fedus in his declaration discussed *infra*) Mr. Fedus had primary responsibility for Enzo's 50 patent families and trademark matters including U.S. and foreign patent and trademark prosecution, opposition and interference proceedings, and litigation involving Enzo's intellectual property rights. In addition, Mr. Fedus handled non-intellectual property matters including real estate transactions, licensing matters, contracts, and even at least

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<sup>8</sup> The USPTO appears to overlook that, all things being equal, it would have actually been less expensive for Enzo to have maintained pendency of this application, rather than remit the 2 expensive 1.137(b) petition fees and the continuing application. This further confirms the inadvertence of the abandonments in this application.

one employment related lawsuit against Enzo. It therefore should not come as a surprise to the USPTO that prosecution deadlines in some Enzo applications were inadvertently missed, and, moreover, were not discovered or remedied until more time passed. This is even more understandable in light of Enzo's docketing and filing systems, discussed in more detail by Mr. Fedus in his Declaration, and by Ms. Curtin and Ms. Liu in their respective Declarations, and supplied as requested by the Order.

#### The Fedus Declaration

Mr. Fedus reiterates the statements of unintentional delay made in the petition of record in this application: that in each application listed in the Order, the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional and that the abandonments of the applications in issue were also unintentional.

Mr. Fedus also recounts the diligent efforts he made (including four trips: on July 10, August 27, September 2, and September 10, 2008) to visit off-site storage facilities and former Enzo office to recover any available documentary docketing evidence requested by the order. He explains that due to the long time involved, three computer failures, and several corporate relocations, his efforts to locate his detailed prosecution chronologies and Enzo patent dockets for the applications listed in the Order were mostly unsuccessful.

Of particular relevance to the Order is Mr. Fedus' explanation of the docketing system as it existed for most of the period set forth in the Order. Mr. Fedus notes that as a matter of his general policy, he always tried to reply in the fullest, and never abandoned an application (which he later attempted to revive) intentionally or intentionally delayed

filing the petition and response to the outstanding Office action. In situations where an application became inadvertently abandoned, revival deadlines were docketed when Enzo became aware of abandonment, which was mostly at the time of receipt of a Notice of abandonment

Docket entries such as due dates, once calculated, were not removed after a response was filed but were removed or updated, if at all, only after receipt of an Office Action. As a result, the docket did not always reflect the actual status of an application. It was necessary to check the application file when the patent docket did not indicate a response was filed and/or was due. Because the patent docket was manual, there were times when due dates were missed simply because Mr. Fedus had not been apprised that a deadline was imminent. Given the docketing system in place by Enzo for most of the time period covered by the Order, that did not apprise Mr. Fedus of the status of an application (other than one having notation that a petition to revive was needed) this reinforces Mr. Fedus' statement that he did not intentionally permit an application to become abandoned. The USPTO is respectfully reminded that while the submission of evidence of a highly sophisticated, reliable docketing system is essential to showing unavoidable delay in a petition filed under 37 CFR 1.137(a), that is immaterial to each and every application mentioned in the OSC, since Enzo has continuously asserted *ab initio* that the delay in every application was unintentional within the meaning of 37 CFR 1.137(b); Enzo does not have to show that it had in place a reliable and sophisticated docketing system to establish that the delay was unintentional. Indeed, the docketing system actually employed at Enzo for most of the period relative to the OSC reinforces



Enzo's contention that both the abandonment and any delay in filing the petition were unintentional.

It was Mr. Fedus' general practice to monitor pending applications, but nonetheless, a small percentage of his active prosecution matters inadvertently became abandoned. This proactive monitoring is amply demonstrated in several instances noted by Mr. Fedus where he actually prepared and filed a petition to revive under 37 CFR 1.137(b) either in advance of Enzo's receipt of the Notice of Abandonment, or notwithstanding that a Notice of Abandonment was ever mailed by the USPTO or received by Enzo, in three of the applications listed in the Order: '067, '576, '075. Clearly, such proactive monitoring is inconsistent with the USPTO's allegation that there was intentional delay in either prosecution during pendency or in filing petitions to revive in the applications listed in the Order, particularly since Enzo's manual docketing system meant that Enzo's first awareness of the fact of abandonment was either receipt of Notice of Abandonment as in this application, or a call from the examiner checking to ascertain whether a response had been filed. As such, it is not understood how these three applications suggest any deliberate actions (or inactions) on the part of Enzo in seeking revival as to support the allegations made in the Order.

Indeed, the USPTO records in Enzo applications are demonstrably less than fully accurate, and to base the OSC on inaccurate USPTO file records and incorrect or incomplete USPTO activities is particularly unseemly. For example in application No. 11/403,117 Enzo has filed a petition to withdraw the erroneous holding of abandonment due to Enzo's demonstrated failure to receive the Office Action of October 29, 2008. This lack of receipt is due in turn to the USPTO failure to follow its own stated

procedures for changing a correspondence address. That is, a correspondence address may only be changed by (1) the written concurrence of all named inventors, or (2) the written instructions of the attorney of record, or (3) the written instructions of the assignee of the entire interest upon its becoming of record. In this case however, a paper filed by a person with a similar name with that of one of the named inventors in application 11/403,117 was somehow matched up with that Enzo file, and despite the presence of but one signature in an application naming joint inventors, the correspondence address was improperly changed by the USPTO such that Enzo did not receive the next USPTO communication; rather it was mailed to the address of a third party. Nevertheless, in spite of the obvious error by the PTO in mailing the Office action to an incorrect address based on PTO's incorrect handling of a change of address filed by an unauthorized person, the PTO nevertheless refused to vacate the holding of abandonment and instead, insisted that Applicant, Enzo, file a Petition demonstrating that the Office Action was not received. That Petition is still awaiting a decision by the PTO. The significance of this recent PTO error is to raise the possibility that the PTO may have committed similar errors relative to one or more of the applications that are now belatedly being subjected to the OSC, as it raises a question as to whether an Office action in one or more of the cases being subjected to the OSC was even properly mailed by the PTO. Had the PTO refused to grant the petitions to revive around the time when they were filed, Enzo would have been in a position to review its records more closely to see if PTO error may have caused some of those abandonments. It is patently unfair for the PTO to ignore errors it makes in its mailing of Office actions as clearly demonstrated in application 11/403,117 and yet be able to revisit many years later earlier grants of

petitions rendered, long after Enzo could be reasonably expected to have possession of records that would substantiate the correctness of statements made by a registered practitioner in good standing.

The Order also notes, in support of its alleged pattern of supposedly deliberate Enzo “abandonment and revival,” that several of the applications listed in the Order were revived at or near the 1 year date and as such, implies that there was deliberate delay in revival. As Mr. Fedus notes in his Declaration, however, revivals were docketed on the monthly anniversary including the 1 year “deadline”. Ms.Lisa Curtin explains in her Declaration that she routinely docketed petitions to revive an abandoned application on a monthly basis based on both the actual date of abandonment as well as the date of the Notice of Abandonment. This is an important point for the UPSTO to consider. The USPTO seems to imply that Enzo, in those applications listed on the Order, docketed the petitions to revive *only* at the one year date and promptly forgot about those applications for an entire year. Moreover, it is one thing to simply docket an application for revival on the 1 year anniversary date and then take no further action for an entire year, and another thing, as Enzo did, to docket it for revival *throughout* that year, begin work on that revival petition and its necessary response to continue prosecution as promptly as conditions permit, and annotate the 1 year anniversary date as a “fail safe,” prudent reminder to guard against unintended forfeiture if the petition had not already been filed. This is precisely what happened here.

Mr. Fedus also includes in his Declaration, along with his general background discussion as to docketing at Enzo, and exemplifies his typical procedures using the '073 application as an illustrative example. For those applications abandoned prior to the

advent of Ms. Lisa Curtin's handling of docketing work, the usual Enzo practice was for the secretary (or Mr. Fedus himself, during the absence of competent secretarial help) to write or stamp the date of receipt of an Office action and docket the due date for Reply. Due to the passage of time, corporate law office relocations, and personnel turnover, memories have faded, and earlier Enzo records cannot be found. Nevertheless, the docketing system employed by Ms. Curtin beginning in 1997 reasonably followed the prior practices at Enzo.

#### The Curtin and Liu Declarations

The Declarations of Ms. Lisa Curtin, whose duties included docketing at Enzo from 1997-2003 and Ms. Amanda Liu, Enzo paralegal, who took over the docketing responsibility from 2005 to the present, are included. The surviving docket records attached to Ms. Curtin's Declaration demonstrate Enzo docketing procedures in general, and are relied upon to show Enzo's general approach to docketing replies to Office Action and the petitions to revive, which were followed in this application. Although Ms. Liu's docket work is subsequent to the time period relevant to this application, her statements corroborate Mr. Fedus' Declaration.

It is submitted that this renewed petition, and the attached Declarations and exhibits are an adequate reply to the Order, and refute the allegations of intentional delay in prosecution and in submitting the petition to revive, and as such again confirm the affirmations made in the original petitions to revive.

Comments Specific to the '772 and the Instant '069 application

The '772 application

The Office action was mailed on November 4, 1993. Mr. Fedus has not been able to locate any docket entries for this Office action but the action would have been docketed in the usual manner in Enzo's manual docket log. The Notice of Abandonment was mailed on June 9, 1994 and was stamped as being received by Enzo on June 13, 1994.

No documentation has been located in regard to activity in prosecuting this application. However, Mr. Fedus believes that the application which was an important application for Enzo would have been diligently and continuously prosecuted in the same manner as all of Enzo's applications were prosecuted.

Mr. Fedus states in his Declaration that, during this time period, he was the only patent attorney employed by Enzo. Mr. Fedus also states that, during this time period, Enzo was involved in two major litigations as well as two applications in the European Patent Office. Mr. Fedus also states that while he was quite busy with all of the prosecutions, litigations and oppositions, it was always his general practice to diligently and continuously prosecute all applications including this application.

The filed petition does indicate that the petition is being filed within the one year deadline imposed by the pre-1994 Rule changes. However, Mr. Fedus unequivocally states that the work on the preparation of the reply and petition was not intentionally delayed in reliance on this one year date.

Mr. Fedus also attests that because of the manner in which the Enzo's docket log functioned, he only actually became aware of the abandonment, at the earliest, on the June 13, 1994 receipt date of the Notice of Abandonment. The petition was filed 239 days from the date at which Mr. Fedus became aware of the abandonment.

#### The Instant '069 Application

In the '069 application, an Office action was mailed on Dec. 28, 1995 and was stamped as received by Enzo on January 2, 1996. The stamp also indicates a 3 month reply date and a handwritten note on the action indicates the 6 month response date. Mr. Fedus has tried to find docket logs or chron files for this period of time but none were found. Mr. Fedus states that the docketing and prosecution efforts in this application would have been same as was his usual practice during the time at which he has been a patent attorney at Enzo.

A notice of abandonment, the means that would make Mr. Fedus aware that the application may have unintentionally become abandoned, was mailed on July 22, 1996 and was stamped as received three days later on July 25, 1996.

A petition to revive along with an amendment was filed on March 28, 1997, 249 days after receipt of the Notice of Abandonment. The substantive amendment included an amendment to the specification and an amendment to the claim along with arguments rebutting the rejection in the Office action.

In the petition granting Enzo's petition to revive, the Petitions Examiner advised Mr. Fedus that the filing of a petition cannot be delayed and that a person seeking revival

due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered until the petition filing date was unintentional. The Petitions Examiner appeared to have concluded that there was no evidence of an intentional delay and indicated to Mr. Fedus that he should correct the record if the Petitions Examiner was mistaken. No clarification was deemed necessary by Mr. Fedus since he believed that he had acted diligently and continually and this application in which Enzo has an ownership right. Mr. Fedus notes that he has diligently prosecuted the '069 application to the present without any subsequent abandonment.

The petition to revive was filed 249 days from the earliest date Mr. Fedus may have become aware of the abandonment, i.e., 249 days from the date on which Mr. Fedus and Enzo would have been aware that the application had become unintentionally abandoned.

The foregoing confirms that the USPTO revivals of the '772 application and the instant '069 application were proper.

#### Relief Requested

It is respectfully requested that the USPTO provide the following relief:

(1) Vacate the Order issued in the above-captioned application as an untimely attempt to reconsider previous decisions of the USPTO; and

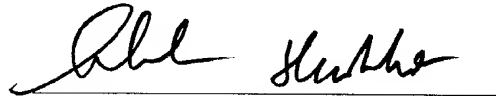
(2) as being based on insufficient evidence that the earlier grants of the petition under 37 C.F.R. § 1.137(b) were not proper;

(3) thereby confirming the correctness of the earlier grants of Petitions to Revive filed in the above-captioned application as well as all applications subject to the Order to Show Cause.

Favorable consideration is respectfully requested.

Respectfully submitted,

HERSHKOVITZ & ASSOCIATES, LLC

A handwritten signature in black ink, appearing to read 'Abraham HersHKovitz', is written over a horizontal line.

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